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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,385	02/01/2002	Jacqui Gates	004770.00525	8435
22907 7590 04/01/2008 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
DAO, MINH D				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/060,385

Applicant(s)

GATES, JACQUI

Examiner

MINH D. DAO

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21, 23, 27, 30 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21, 44, 46 and 47 is/are allowed.
- 6) ☒ Claim(s) 23, 27, 30, 45 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/27/07 have been fully considered but they are not persuasive.

Regarding claims 23, Applicant, on page 7 and 8, argues that Kamada does teach that "the composition of the associated email or facsimile is not initiated prior to selecting the associated address or number from the contact list". Examiner notes that this limitation is not recited in the claim. Claim 23 fails to indicate a priority or order of the actuations of the elements recited in the claim. Even if the "order of the actuations of the elements recited in the claim" was recited in the claim, the result of claim 23 and the result of the teaching of Kamada (see figs. 7,8; col. 8, line 16 to col. 9, line 24) would be the same. Claim 23 and its dependent claims remain rejected for the reason above.

Claims 45 and 50 remain rejected for the same reason set forth above.

Regarding claim 27, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986). In this case, Examiner only relies on Laursen for the teaching of A Bookmarks 316 showing personalized bookmarks 321 that allows the user to establish a list of web sites he/she may frequently visit through his/her cellular client. For example, StockTIPS referenced by 322 allows the user to keep a list of stock symbols there. With the personalized bookmarks, the user, when on the go, can quickly enter into the web pages in his list related to stock to find the prices thereof currently being traded in the stock market without keying in any symbols at all (see fig. 9; sections [0060-0062] as previously cited.). Therefore, Metso and Laursen once combined read on the limitations of claim 27.

Claims 27, 30, and 50 remain rejected for the reason set forth above.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 23,45,48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metso et al. (US 5,920,826) in view of Kamada et al. (US 6,192,258).

Regarding claim 23, Metso teaches a method comprising:

a) accessing a list of contacts stored in the memory of a mobile phone, each contact in the list of contacts having at least one telephone number field for storing an associated telephone number and a name field for storing an associated contact name; b) selecting a contact from the list through an user interface having a scroll key; c) receiving a short cut key activation to compose a text message (see Metso, figs. 9 and 10; col. 9, lines 22-26; col. 11, lines 22-67). However, Metso does not disclose d) upon activation of the short cut key, displaying a screen to compose a text message; and e) if the selected contact includes at least one telephone number in the associated telephone number field, automatically entering the telephone number into a recipient address field of the displayed compose text message screen. These limitations are taught by Kamada (see figs. 7,8; col. 8, line 16 to col. 9, line 24). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the teaching of Kamada to Metso for the benefit of being able to create and edit a e-mail message as taught by Kamada.

Regarding claim 45, since the claim includes the same limitations as that claim 23, the rejection of claim 23 is herein incorporated.

Regarding claims 48-49, see Metso, figs. 9 and 10; col. 9, lines 22-26; col. 11, lines 22-67 and Kamada (figs. 7,8; col. 8, line 16 to col. 9, line 24).

Regarding claim 50, the rejection of claim 23 is herein incorporated.

3. Claims 27,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metso et al. (US 5,920,826) in view Laursen et al. (US 2004/0229595).

Regarding claim 27, the rejection to claim 23 over Metso et al. (US 5,920,826) as set forth above is herein incorporated. In addition, Metso fails to teach entering URL contact list and receiving a short cut key activation; and upon receipt of the short cut key activation connecting to the URL as specified in the claim. Laursen et al. (US 2004/0229595), in an analogous art, teaches entering a Web page (URL address) and composing an e-mail message (see figs. 9,10; sections [0060-0062]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the teaching of Laursen to Metso for the benefit of being able to quickly enter a web site without having go through several steps as taught by Laursen.

Regarding claim 30, the combination of Metso and Laursen teaches that each contact has at least one of a telephone number and a URL address field for storing at least one of an associated telephone number and additional URL information therewith in addition to the e-mail address field, the user interface providing short cut key being operable to either access a screen for composing an e-mail message, access a screen for composing a text message or connect to the URL address in dependence on a default

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programming option selected by the user (see Kamada, figs. 7 and 8; col. 8, 16 to col. 9, line 24).

Allowable Subject Matter

4. Claims 21, 44, 46, and 47 are allowed.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D. DAO whose telephone number is (571)272-7851. The examiner can normally be reached on 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW ANDERSON can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MINH DAO
/M. D. D./
Art Unit 2618

/Matthew D. Anderson/

Supervisory Patent Examiner, Art Unit 2618